

REMARKS/ARGUMENTS

These remarks are being submitted in response to the Office Action dated November 19, 2004. Claims 1-7, 9-18, and 20-23 are pending in the present application. Independent claims 1, 12, and 23 have been amended, and claims 1-7, 9-18, and 20-23 remain pending. The Examiner's indication that claims 2-7, 9-11, 13-18, and 20-22 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims is acknowledged and appreciated.

Independent claims 1, 12, and 23 have been amended to recite that images are uploaded from a hand-held image capture device to a server "over a network". Support for the amendment can be found throughout the specification, for example, the server is described as part of a photosharing website, and in a preferred embodiment, the image capture devices are described as being provided with wireless connectivity for connecting to the Internet (see pages 5-7 for example). Accordingly, it is respectfully submitted that no new matter has been entered. As this amendment makes clear what implicit in the claims, i.e., the presences of a network, this amendment is seen by Applicant as cosmetic, and as such, is not subject to the prosecution history estoppel imposed by Festo.

§102 Rejections

The Examiner rejected claims 1 and 12 under 35 USC §102(b) as being anticipated by Sarbadhikari (US 5,477,264). Applicants respectfully disagree.

In contrast to the present invention, Sarbadhikari provides an electronic imaging system that includes an electronic camera for capturing and storing images in a removable storage device which is also preloaded with software for operating the image

system (column 2, lines 51-55). The removable memory may contain image templates or overlays for combination with user-captured images (col. 10, lines 24-28). The user selects images and overlays from a view screen. After images are captured and overlays the selected, the images and overlays are uploaded to a computer via the removable memory or a cable interface.

Anticipation requires that the reference teach each and every element of the claims. It is respectfully submitted that Sarbadhikari fails to teach and suggest each and every element of the independent claims. First, Sarbadhikari fails to teach or suggest "a method for allowing a user to select actions to be taken by a *server* when uploading images from a hand-held image capture device," as claimed. Sarbadhikari discloses a computer for storing images uploaded from the digital camera, but nowhere does Sarbadhikari describe that the computer functions as a server or that the digital camera is connected to the server via a network. Rather, the images from Sarbadhikari's digital camera must be uploaded from the removable memory, or using a "standard electrical computer interface cable, such as a RS-232 or SCSI interface connection" (col. 11, lines 24-26). Accordingly, it is respectfully submitted that Sarbadhikari's disclosure as a whole dictates that the type of computer contemplated is a conventional PC, rather than a "server", as claimed.

Sarbadhikari further fails to teach or suggest "downloading an *action list* from the server to the image capture device after *the image capture device establishes a connection with the server*," as recited in step (a) of claim 1. The Examiner cites Sarbadhikari's frames/overlays for teaching an action list. However, as recited in independent claims, "the action list includes one or more items representing actions that the server should take with respect to uploaded images." In contrast, Sarbadhikari

defines a frame/overlay as "pre-existing image data files, i.e., files with images not captured by the camera system" (column 5, line 20).

The Examiner cites Sarbadhikari for teaching that "while the captured image may be shown through the overlay in the viewfinder, the camera may not actually combine these images, but rather create a script file which would direct the computer to do the proper combination" (Col. 11, lines 5-9). In this embodiment, however, the camera creates the script, which requires client-side processing. In the present invention, no processing of any data is required by the actions "that the server should take with respect to images."

Even if one assumes, that the script file can be considered analogous to "an item representing an action that the server should take, Sarbadhikari would still fail to teach or suggest "a list" of action items/scripts that are "downloaded" from the server to the image capture device, as recited in independent claims 1 and 12. Although Sarbadhikari refers to frames/overlays in the plural, not only does Sarbadhikari fail to teach or suggest "a list" of such items present on the removable memory, but also fails to teach or suggest that the list of such items is "downloaded" from the computer to the camera. The Examiner cites Sarbadhikari's cable 38, figure 11 for teaching "downloading" an action list. Applicants, however, have studied Sarbadhikari and believe Sarbadhikari to only teach the uploading of data from the digital camera to the computer, not the reverse. Assuming *arguendo*, however, that the downloading of data to the digital camera from the computer is taught somewhere in Sarbadhikari, Sarbadhikari would still fail to teach doing so over "a network."

Sarbadhikari also fails to teach or suggest "displaying the action list to the user on the image capture device *after the user initiates an image upload process*, as recited

in independent claims 1 and 12. Applicants understand Sarbadhikari's process to work as follows. First, the removable memory is provided with frames/overlays. The user then captures images, which are then stored on the removable memory. The user may then select images and overlays from the viewfinder of the camera, and the camera creates the script file that directs the computer to do the proper combination. And finally, the contents of the removable memory are uploaded to the computer, either directly from the memory card, or via a computer cable. Thus, in Sarbadhikari, the frames/overlays are displayed to the user *before* the user initiates the image upload process, rather than after, as recited in independent claims 1 and 12.

Accordingly, because Sarbadhikari fails to teach each and every element of the independent claims, Sarbadhikari fails to anticipate the present invention under §102.

The Examiner rejected claim 23 under 35 USC §102 (e) as being anticipated by Safai (US 6,167,469). Applicants respectfully traverse the rejection.

In contrast to the present invention, Safai is directed to a method and apparatus for transporting digital images from a digital camera to a server. The digital camera executes a transport application that enables a user to send one or more pictures from the camera to one or more external addresses (column 7, lines 31-37). When the transport application is launched, a top-level view of the functions available in the transport application is displayed to the user (column 8, lines 21-27). As shown in figure 4A, the functions include selecting address, choosing a photo, recording a voice message, and sending a photo.

The present invention is a server-side processing architecture, where a selected action is uploaded to the server along with an image and the server performs the action on the image. In contrast, Safai is directed to a standard client-server architecture that

is well-known in the art at the time and similar to the prior art discussed in the Background of the present application. In such client-server architecture, application software is required on the client device to process data prior to sending the data to the server. Thus, Safai fails to teach or suggest "A method for allowing a user to select *actions to be taken by a server* when uploading images from a hand-held image capture device, as recited in the present invention, because Safai requires the client to perform some, if not all of, the requested action. That is, the action request is sent to the client side application which begins processing the action. The processing may be completed on the server, but no action request or command is transmitted from the device to the server. On page 4 of the Office Action, the Examiner states with respect to Safai: "... and note that each action is stored in the camera's memory to be executed by the CPU to 10, figure 2) *on the image capture device*. Thus, the Examiner acknowledges that the actions are performed by the image capture device, rather than the server.

Applicants further disagree that Safai teaches or suggests an "action list including one or more items representing actions that the server should take with respect to uploaded images, including any combination of specifying a storage location, sending the images to one or more email addresses; and analyzing or performing calculations on the images." Examiner cites Safai column 15, lines 27-58; column 13, lines 10-25; and column 14, lines 30-42. The sections, however, are not describing generic actions to be taken by the server; they are describing a routing mechanism. The operations performed by the server in Safai are determined by a valid address, which the user must enter on the camera. The actions in Safai are thus not predefined items as in the present invention.

In addition, Safai describes that each "action" selected results in an application being launched on the client (i.e., an email application for email, a print application for print, and a camera settings application for settings). This means that for any given "action", Safai requires executable code on the camera specific to the action to fulfill the request. The graphical interface cited by the Examiner includes four actions, two of which, image editing and change camera settings, are traditional client functions only. Safai describes neither of these actions so how they are processed is unknown. The processing of another action, "Print," is unclear since Safai does not describe its operation at all. Print functions on a camera were not unusual at the time of Safai's application, but the typical print functions are either a direct-to-printer command or through a PC host. Since Safai doesn't describe the print application, it's not clear what role the client and server play. Safai does mention printing in the context of the transport application, but it's merely a mechanism for delivering an image to a postal address and thus part of the transport applications routing function and not a general print feature.

Of the applications displayed on the main menu of the client device, Safai only describes the detailed operation of the "Mail" or transport application. It appears that the Examiner has misinterpreted Safai's mail transport application as the action being performed by the server, when in fact, all the transport application does is route images based on the address and address type. The Mail application clearly requires client side processing, and the mail transport application does not send an action to the server, only photos, addresses, and voice messages. The action to be performed is fixed and implicit. It is hard-coded in the relationship between the client-side code and the server-side code. The server simply routes information based on address type (Col.

14, line 8 through Col. 15 line 11). The other services described by Safai are either initiated after upload time (e.g., from a web browser or remotely from the device) or also have a client specific piece and a server specific piece (print).

It is respectfully submitted that the specification of an address, as in Safai, is non-analogous to an action request, since routing based on addresses and address type was well-known at the time and similar to the prior art email feature discussed in the Background of the present application. The printing feature referred to by the Examiner in this regard is merely another aspect of the routing function of the transport application. Printing only takes place when an addressee has a mailing address. It is not in this sense an action distinct from the general routing action performed by the transport application. No print request is sent from the client to the server, merely an address is sent.

Accordingly, Safai fails teach or suggest each and every element of claim 23, and therefore claim 23 is patentable over Safai.

In view of the foregoing, it is submitted that independent claims 1, 12 and 23 are allowable over the cited references. Accordingly, Applicant respectfully requests reconsideration and passage to issue of claims 1-7, 9-18, and 20-23 as now presented.

Based on the foregoing, Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,
SAWYER LAW GROUP LLP



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Date

Stephen G. Sullivan
Attorney for Applicant(s)
Reg. No. 38,329
(650) 493-4540